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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/827,008

04/05/2001

Richard M. Mathis

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4898

58076

7590

06/23/2006

REED SMITH, LLP  
TWO EMBARCADERO CENTER  
SUITE 2000  
SAN FRANCISCO, CA 94111

EXAMINER

TSAI, SHENG JEN

ART UNIT

PAPER NUMBER

2186

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/827,008		MATHIS, RICHARD M.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sheng-Jen Tsai		2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) 1-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This Office Action is taken in response to Applicant's Amendments and Remarks filed on June 5, 2006 regarding application 09/827,008 filed on April 5, 2001.

2. Claims 1-73 have been previously cancelled.

Claims 74, 78, 82, 85-88, 90 and 92-93 have been amended.

Claims 74-93 are pending for examination.

3. ***Response to Amendment and Remarks***

Applicants' amendments and remarks have been fully and carefully considered.

The rejections of claims 74-92 under 35 U.S.C 112, first paragraph as indicated in the previous Office Action are withdrawn per Applicant's explanation in the Remarks and the corresponding amendments.

The objection of claim 93 under 35 U.S.C 112, second paragraph as indicated in the previous Office Action is withdrawn per Applicant's explanation in the Remarks and the corresponding amendments.

However, claims 74, 77-78, 81, 88 and 92-94, as currently presented, again raise issue of second paragraph, respectively. Refer to the corresponding sections below for details.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 74-94 are rejected under 35 U.S.C. 112, second paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 74 recites **“the secondary secure memory device is physically and operationally independent of the primary device.”** The element “the secondary secure memory device” lacks antecedent basis. Note that claim 74 recites “storing the calculated signature in a secondary memory device separate from the primary device” in the earlier portion of the claim.

Claims 75-91 are rejected by virtue of their dependence from claim 74.

Further, claim 77 recites “The method according to Claim **75**, wherein the step of placing a pattern on the data bus path comprises switching the data bus path to a predetermined pattern that causes the control processor to remain in a predetermined state.” The element “the data bus path” lacks antecedent basis. Note that claim **76** does recite the element “a data bus path,” but not claim **75**.

Further, claim 78 recites “The method according to Claim 74, wherein the memory protection unit is configured to read the contents of the primary memory device as needed for calculation of the first and second signatures but operates independently of the primary memory device.” The element “the memory protection unit” lacks antecedent basis.

Further, claim 88 recites “The method according to Claim 74, wherein the secondary secure memory module is only accessible by a microcontroller that is

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independent of the control processor.” The element “the secondary secure memory module” lacks antecedent basis. Note that claim 74 recites “storing the calculated signature in a secondary memory device separate from the primary device” in the earlier portion of the claim.

Claim 92 recites “the secondary secure memory module is not accessible by the control processor and is physically independent of the primary memory device.” The element “the secondary secure memory module” lacks antecedent basis. Note that claim 74 recites “storing the calculated signature in a secondary memory device separate from the primary device” in the earlier portion of the claim.

Claim 93 recites “calculating a signature from contents of the program memory, the signature comprising a signature of an image of binary content of the program memory comprising a verification of the contents of the program memory.” It is understood that what “the signature comprising a signature of an image of binary content of the program memory” means; however, the second portion of this limitation, as it currently presented, appears to state that “the program memory comprising a verification of the contents of the program memory,” which is inconsistent with other recited limitations.

Claim 94 is rejected by virtue of their dependence from claim 93.

The merits of patentability of independent claims 93-94 are not further analyzed in this Office Action, pending clarification from Applicant.

### ***Claim Objections***

6. Claims 81 and 94 are objected for minor informality.

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Claim 81 recites the element "ATM machine." There are at least two acronyms of "ATM" that are well known in the art: the Asynchronous Transfer Mode and the Automatic Teller Machine. The Applicant needs to spell out the full name of the intended target to avoid ambiguity.

Claim 94 recites the element "The method according to Claim 93, the wireless unit is a blue tooth device."

First, claim 93 refers two devices, the memory test unit and a RAD, engaging in wireless communication, thus both of them must be wireless devices. It is not clear which of these two elements is the intended "the wireless unit" recited in claim 94.

Second, the element "a blue tooth device" should be "a Bluetooth device."

#### ***Allowable Subject Matter***

7. Claims 74-92 are rejected under 35 U.S.C. 112, second paragraph, but would be allowable if able to clarify and overcome the rejections.

#### **8. *Related Prior Art***

The following list of prior art is considered to be pertinent to applicant's invention, but not relied upon for claim analysis conducted above.

- Martin, (US 5,729,212), "Gaming Device Providing High Security Communications with a Remote station."
- Wess et al., (WO 98/52664), "Gaming Device Security System: Apparatus and Method."
- Olarig et al., (US 6,009,524), "Method for the Secure Remote Flashing of a BIOS Memory."

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- Mattison, (US 5,778,070), "Method and Apparatus for Protecting Flash Memory."
- Cragon et al., (US 3,573,855), "Computer memory Protection."

***Conclusion***

9. Claims 74-94 are rejected as explained above.

Claims 74-92 are rejected under 35 U.S.C. 112, second paragraph, but would be allowable if able to clarify and overcome the rejections.

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**11.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheng-Jen Tsai whose telephone number is 571-272-4244. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on 571-272-4182. The fax


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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheng-Jen Tsai  
Examiner  
Art Unit 2186

June 21, 2006

  
**PIERRE BATAILLE**  
**PRIMARY EXAMINER**  
6/21/06